

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-14 are now in the application. Claims 1, 3, and 9 have been amended. Claim 12 has been added, support for which can be found in claim 8 and in claims 4 and 6 of the instant application. Claims 13 and 14 have been added, support for which can be found in claim 1 and page 14, lines 11-12 of the specification. No new matter has been added.

In the second paragraph on page 2 of the Office action, claim 1 has been rejected as being obvious over Schild et al. (U.S. Patent No. 5,370,051) (hereinafter "Schild") in view of Kunkel et al. (U.S. Patent No. 4,707,902) (hereinafter "Kunkel") and Berg (U.S. Patent No. 3,384,014) under 35 U.S.C. § 103.

The rejection has been noted and claim 1 has been amended in an effort to even more clearly define the invention of the instant application. The claim is patentable for the reasons set forth below. Support for the changes is found on page 14, lines 11-12 of the specification. Furthermore, since new claims 13 and 14 include limitations of claim 1, new claims 13 and 14 will be discussed with respect to this rejection as well.

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1, 13, and 14 call for, *inter alia*:

inseparably connecting the clamping bar to the blanket material.

The Examiner stated on page 3 of the Office action that the prior art is configured "...so as to facilitate the replacement of the blanket by sliding the blanket relative to the clamping bars." However, in the instant application as claimed, a displacement of the blanket material relative to the clamping bar is not possible because the clamping bar is inseparably attached to the blanket material. This is further clarified by the amendment to claim 1.

The Berg reference discloses that to remove the blanket, the bar is slid endwise off of the blanket out of the throat slot (29) and the interconnecting slot (28).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

None of the references shows or suggests inseparably connecting the clamping bar to the blanket material, as recited in claims 1, 13, and 14 of the instant application.

Neither Schild nor Kunkel disclose a clamping bar.

Furthermore, Berg discloses a clamping bar that is separably connected to a blanket.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the references cited by the Examiner do not produce a *prima facie* case of obviousness.

Furthermore, regarding the combination of Schild, Berg, and Kunkel the following remarks are provided:

First, the Kunkel reference discloses including recesses (14 and 15) directly in the rubber blanket (26) (column 2, lines 54-56). A person of ordinary skill in the art realizes that the teaching of Kunkel is cost effective because it makes it possible to eliminate the need for clamping bars. Therefore, Kunkel teaches a person of ordinary skill in the art away from the object according to claims 1, 13 and 14 of the instant

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

application. Therefore, the person of ordinary skill in the art does not have any motivation for the use of clamping bars.

Furthermore, the Berg reference teaches that the notches in clamping bars are supposed to have a completely closed and thus not a u-shaped inner contour. In the invention of the instant application, typical register cut-outs are used. It is common knowledge that typical register cut-outs lead into a leading edge, i.e. in the state of the art they lead into the leading edge of the blanket material (prior art reference Kunkel U.S. Patent No. 4,707,902; Fig. 6 positions 14 and 15), in Schild they lead into the leading edge of the printing plate, and in the invention of the instant application they lead into the leading edge of the clamping bar 11 (Fig 2, positions 23 and 24). In other words, the shape of a typical register is not closed, it is substantially u-shaped. Therefore, the combination of Kunkel, Schild, and Berg would not lead to a rubber blanket configuration having a clamping bar with substantially u-shaped register cut-outs formed therein.

Based on the above-provided comments, claims 1, 13, and 14 are believed to be allowable.

Applic. No. 09/694,569  
Amdt. dated April 8, 2004  
Reply to Office action of January 8, 2004

In the first full paragraph on page 3 of the Office action, claim 8 has been rejected as being obvious over Berg (U.S. Patent No. 3,384,014) in view of Kunkel (U.S. Patent No. 4,707,902) under 35 U.S.C. § 103.

As will be explained below, it is believed that claim 8 was patentable over the cited art in its original form and claim 8 has, therefore, not been amended to overcome the references. Furthermore, since new claim 12 includes limitations of claim 8, new claim 12 will be discussed with respect to this rejection as well.

Claims 8 and 12 call for, *inter alia*:

the rubber blanket configuration having a clamping bar with substantially u-shaped register cut-outs formed therein.

Applicants respectfully disagree with the Examiner's position that "it would have been obvious to one of ordinary skill in the art to provide the clamping bar of Berg with u-shaped cut-outs as taught by Kunkel et al in order to speed up the rubber blanket registration process since the u-shaped cut-outs would more easily engage the register pins than circular openings."

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added).

The Berg reference teaches that the notches in clamping bars are supposed to have a completely closed and thus not a u-shaped inner contour. In the invention of the instant application, typical register cut-outs are used. It is common knowledge that typical register cut-outs lead into a leading edge, i.e. in the state of the art they lead into the leading edge of the blanket material (prior art reference Kunkel U.S. Patent No. 4,707,902; Fig. 6 positions 14 and 15), and in the invention of the instant application they lead into the leading edge of the clamping bar 11 (Fig 2, positions 23 and 24). In other words, the shape of a typical register is not closed, it is substantially u-shaped. Therefore, the combination of Kunkel and Berg would not lead to a rubber blanket configuration having a clamping bar with substantially u-shaped register cut-outs formed therein.

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

The Berg reference discloses that bolts (31) pass through circular openings (30) of bar members (21 and 22) and are received in threaded openings of the roller body (12).

Because the Berg reference discloses that the clamping bars are held in place with the bolts (31), there is very little surface area under the bolt head to generate enough holding force to hold the clamping bars of Berg in place.

Accordingly, Berg explicitly discloses that the openings (30) are completely circular in their form and not slotted as suggested by the Examiner. Because the clamping bars of Berg are held in place only with bolts, a person of ordinary skill in the art does not have any motivation to modify the openings of Berg to make them u-shaped as suggested by the Examiner.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999).

Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or



Applic. No. 09/694,569  
Amdt. dated April 8, 2004  
Reply to Office action of January 8, 2004

suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Applic. No. 09/694,569  
Amdt. dated April 8, 2004  
Reply to Office action of January 8, 2004

In the first full paragraph on page 4 of the Office action, claim 9 has been rejected as being obvious over Kowalczyk et al. (U.S. Patent No. 5,094,164) (hereinafter "Kowalczyk") in view of Kunkel (U.S. Patent No. 4,707,902) under 35 U.S.C. § 103.

The rejection has been noted and claim 9 has been amended in an effort to even more clearly define the invention of the instant application. The claim is patentable for the reasons set forth below. Support for the changes is found on page 10, line 16 to page 11, line 3 of the specification.

It is noted that the corporate assignee of the Kowalczyk reference is also the assignee of the instant application, therefore, applicants are very familiar with the reference.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 9 calls for, *inter alia*:

the substantially u-shaped register cut-outs and the further substantially u-shaped register cut-outs both corresponding to the register pins of the cylinder.

Applic. No. 09/694,569

Amdt. dated April 8, 2004

Reply to Office action of January 8, 2004

Furthermore, the instant application discloses that is extremely well suited for printing or varnishing machines having clamping devices permanently arranged on the cylinder, the clamping devices having been originally provided only for fastening a printing plate, and being now also selectively used for fastening the rubber blanket. In the method according to the invention, the actions of aligning the register cut-outs in relation to the register pins, and firmly clamping the rubber blanket are performed within the printing or varnishing machine.

The Kunkel reference discloses a blanket having register cut-outs, which correspond to register pins of a clamping device. The blanket is assembled to the clamping device outside of the press and then the clamping devices along with the blanket are then inserted in the blanket cylinder.

The Kowalczyk reference discloses a flexographic printing plate that is attached to a rubber blanket cylinder by engaging u-shaped register cut-outs with register elevations on the rubber blanket cylinder.

The combination of Kunkel and Kowalczyk would include the following:

Applic. No. 09/694,569  
Amdt. dated April 8, 2004  
Reply to Office action of January 8, 2004

- the register cut-outs of the blanket material in Kunkel (hereinafter "first register cut-outs") corresponding to the register pins of the clamping device in Kunkel (hereinafter "first register pins"); and
- the register cut-outs of flexographic printing plate in Kowalczyk (hereinafter "second register cut-outs") corresponding with the register pins of the blanket cylinder in Kowalczyk (hereinafter "second register pins").

Changing from varnishing using the flexographic printing plate to varnishing using the blanket cylinder the following steps would be required:

1. removing the flexographic printing plate from the blanket cylinder;
2. connecting (registering and clamping) the blanket material and the clamping device (outside the press), with cooperation of the first register cut-outs and the first register pins; and
3. connecting the clamping device with the blanket to the blanket cylinder inside of the press.

Applic. No. 09/694,569  
Amdt. dated April 8, 2004  
Reply to Office action of January 8, 2004

Changing from varnishing using the blanket cylinder plate to varnishing using the flexographic printing the following steps would be required:

1. removing the clamping device with the blanket from the blanket cylinder; and
2. connecting (registering and clamping) the flexographic printing plate to the blanket cylinder, with cooperation of the second register cut-outs and the second register pins.

There is no cooperation between the first register cut-outs and the second register pins. Therefore, there is no motivation for a person of ordinary skill in the art to provide first register cut-outs that correspond to the second register pins.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest the substantially u-shaped register cut-outs and the further substantially u-shaped register cut-outs both corresponding to the register

Applic. No. 09/694,569  
Amdt. dated April 8, 2004  
Reply to Office action of January 8, 2004

pins of the cylinder, as recited in claim 9 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the references cited by the Examiner do not produce a *prima facie* case of obviousness.

It is appreciatively noted from page 5 of the Office action, that claims 2-7, 10, and 11 are allowed. It is noted however that claim 3 has been amended so as to delete a repetition of the word "of".

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 8, 9, 12, 13, or 14. Claims 1, 8, 9, and 12-14 are, therefore, believed to be patentable over the art.

In view of the foregoing, reconsideration and allowance of claims 1, 8, 9, and 12-14 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone

Applic. No. 09/694,569  
Amdt. dated April 8, 2004  
Reply to Office action of January 8, 2004

call so that, if possible, patentable language can be worked out.

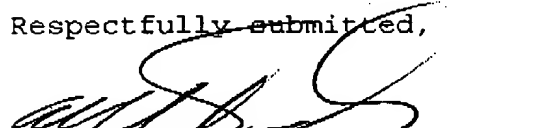
If an extension of time for this paper is required, petition for extension is herewith made.

Enclosed herewith is the fee for three additional independent claims in the amount of \$258.

Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

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For Applicant(s)

AKD:cgm

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